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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,104

Applicant(s)

EDENS, BERTUS KAREL

Examiner

Jeffrey A. Shapiro

Art Unit

3653

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, Jr. et al (US 6,119,051). Anderson discloses Applicant's claimed computer program and apparatus as follows.

As described in Claims 9, 11 and 21;

- a. at least one finishing assembly (60) for producing mail pieces;
- b. a sensor for registering a current physical property of a current condition of said at least one finishing assembly; (See col. 11, table 5, lines 45-65, which indicate that, for example, weight of the mailpiece is sensed. Note that a sensor, such as a scale, would be obvious to use, otherwise, the system would not work to detect weight data, for example. Note also that the system of Anderson detects whether or not a particular mailpiece is a duplicate or not. This again, implies the use of sensors, such as imaging devices, to compare with prior recorded mailpieces.)
- c. representation means (note that the computerized system of Anderson provides a computer with data in the form of a report, such as Table 5, found on col. 11);

d. a control structure (see figure 1) communicatively linked with said finishing assembly, said sensor and said representation means, said control structure being provided with code for;

da. determining data regarding a required operating condition applying to the production of at least one mail piece (see col. 7, lines 5-22);

db. determining at least one physical property to be realized manually of said required operating condition (see col. 9, lines 30-67 and col. 10, lines 1-29, noting that the material is physically loaded on the processing machine);

dc. registering at least one current physical property of a current condition of said mail production apparatus (see table 4, noting that the current location (tray id) and the target destination is recorded/registered in the computer) ;

dd. determining a difference between said at least one current physical property and said at least one property to be realized manually of said required operating condition (note again, the weight recorded in table 5 as well as whether or not the mailpiece is a duplicate or not—see col. 6, lines 1-19);

de. causing an indication associated with said difference to be represented in humanly perceptible form (again, note that all of the

tables and data appear to be presented in report form, readable by humans);

df. causing said at least one mail piece to be composed by said finishing assembly in said operating condition (see again, col. 9, lines 60-67 and col. 10, lines 1-29);

dg. *Subsequently causing said mail piece or said series of mail pieces to be prepared by said mail production apparatus in said operating condition; (see again, col. 9, lines 60-67 and col. 10, lines 1-29)*

As described in Claim 10;

e. an information carrier provided with machine-readable data constituting a computer program (note that it would be obvious to provide the computer program on a number of obvious formats, such as a hard drive, compact disc, or floppy disc);

As described in Claim 12;

f. a memory structure communicatively linked with said control structure for storing data which represents a directly preceding operating condition (note col. 3, lines 64 and 65, which state that the computer is an intel Pentium class computer, which is understood to have a memory, other wise, the record id, for example, as mentioned in col. 4, lines 54-56, would not able to be stored—see also col. 4, lines 1-6);

g. wherein said control structure is further arranged for determining at least one property of said current condition by determining at least one property of said directly preceding operating condition (again, see tables 4 and 5);

As described in Claim 13;

h. said control structure is further arranged for determining operations to be performed manually for bringing said finishing assembly from said current condition into said required operating condition and representing said operations to be performed with said representation means in humanly perceptible form (see col. 4, lines 6-30);

As described in Claim 14;

i. said control structure is further arranged for registering the current condition again after the performance of one of said operations to be performed and representing in humanly perceptible form at least one residual operation of said operations to be performed (see tables 4 and 5);

As described in Claim 15;

j. an item sensor communicatively linked with said control structure, for registering loaded physical postal items (note also the use of an imager in col. 9, lines 30-59);

k. wherein said control structure is further arranged for determining physical postal item types associated with said required operating condition, registering loaded physical postal items, determining at least

one type of said loaded physical postal items, and representing at least one type of physical postal items to be loaded (see col. 7, lines 6-22);

As described in Claim 16;

l. representing with said representation means, in addition to the or each type of physical postal items to be loaded, a loading position for physical postal items of that type to be loaded (see tables 4 and 5);

As described in Claim 17;

m. representing a property of physical postal items of said type to be loaded (again, note that "weight" is represented in tables 4 and 5);

As described in Claim 18;

n. said item sensor is arranged for registering an item property of said loaded physical postal items (note that the imager registers the entire mailpiece, including length, width, and surface features);

As described in Claims 19 and 20;

o. *data regarding said required operating condition is determined prior to the preparation of the mail piece or series of mail pieces; (note that the data used by Anderson's system is determined prior to the setup of the job and that this data is acquired in a fashion such as reading the parameters from the control insert.)*

At the time of the invention it would have been obvious to one ordinarily skilled in the art to have performed any or all of the steps in one of Anderson's control inserts in a manual or semi-automated fashion.

The suggestion/motivation would have been to allow for operator intervention.

Note also that it is obvious for an automated process to be performed manually. As an extreme, but illustrative example, note that instead of transporting the sheets automatically by conveyor, the operator could take the sheets and take them from one station to another after each process of the job is performed.

Therefore, it would have been obvious to use Anderson to obtain the invention as described in Claims 9-21.

Response to Arguments

3. Applicant's arguments filed 5/25/04 have been fully considered but they are not persuasive. As representative of Applicant's claims, consider independent claim 9. It requires determining data regarding said operating condition/s, determining at least one physical property to be realized manually of said required operating condition, registering at least one current physical property, determining a difference between said at least one current physical property and said at least one property to be realized manually of said required operating condition, causing an indication associated with said difference to be represented in humanly perceptible form, and causing said mail pieces to be prepared in said operating condition.

Anderson's system reads on the independent claims. What is termed by Applicant as a property is really an operating parameter. These parameters are described by both Applicant's specification at p.7, lines 28-30 and p.8, lines 1-3 and Anderson at table 5 as including the dimensions of the insert paper, the envelopes, the type of paper, whether to have a z-fold, use stapling, etc.

Regarding realization of a parameter by manual operation of the system, note col. 11, lines 5 and 6 indicate a "pull key", which is a customer defined key to look up a certain mailpiece, and a "user field" which is a customer defined key for customer use. Such keys are construed as user-defined macros, which highly suggests user customizable parameters. Such parameters which are designated user-defined, are changeable from a prior state to a desired state. Otherwise, the system would not work. In other words, the current state of the user-defined parameter can be brought up on screen, its state, changed, therefore changing the program that controls the processing of the job. Therefore, for example, one ordinarily skilled in the art would realize that one could, for example, add an extra insert in addition to the normal single insert, or to add a z-fold to a single insert, which normally does not have one. The change to a user-defined macro is suggested as being placed in a human perceptible form by indication on a computer screen or in paper printout format. See figure 1, which illustrates a report printer and note that indication on either a display or on paper are considered to be functional equivalents of each other.

Note further, col. 9, lines 60-67 and col. 10, lines 14-29, which indicates that "if the 'name' of the database driven insertion data is not specified... the users must select

which set of database driven insertion data to use from the database.” This can be construed to meet the definition of manual realization of at least one physical property and human perceptible indication of a difference in that the “name” of the insertion data is not specified.

Again, as Applicant stated on p. 11, lines 7-9, “the claimed invention provides a computer program which allows an operator to see what needs to be done in order to bring the apparatus into a required condition in order to produce a mail piece. This is just what is described by Anderson—performing a computer-aided insertion job which is able to be operator modified. Therefore, Anderson does not simply disclose a database generation program, but also an entire system for performing a particular insertion job on a mailpiece finishing system. This is also why job tracking performed by Anderson’s system is important to the operator—to allow for operator intervention regarding particular situations.

Applicant is correct that simply “generating database instructions is not the same as bringing an apparatus into a required operating condition prior to preparation of the mailpiece(s),” except where the database instructions are later used to control the setup and operation of the insertion system. This is what is described by Anderson.

Additionally, even if it can be argued that Anderson only teaches tracking job data, one ordinarily skilled in the art would recognize that the data is obtained from information channels such as sensors, and that it would be obvious to use the information in another format, such as sampling it in a real-time manner. Note also that regardless of whether or not the parameter fits the intended use language “to be

realized manually," it can be argued that the system of Anderson and of Applicant's claimed apparatus works the same regardless of how the parameter is realized. Again, note that it would have been obvious to automate a manual process or to make manual automated processes.

Therefore, Claims 9-21, reasonably and broadly construed, are rejected.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shea '104, see claim 1, for example, which describes varying the chassis speed; Baker '821 describes a mailing machine with various modes (see col. 4, lines 58-63) and background functions (col. 5, lines 11-19). Hart '835 describes use of control inserts to control a mailpiece assembly job. Hart '011 additionally describes verification that particular data control records have been used to control assembly of mailpieces. Nunnally '280 describes an insertion system with sensors (see col. 3, lines 35-41) and controlled stopping of the job (see col. 6, lines 1-11).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

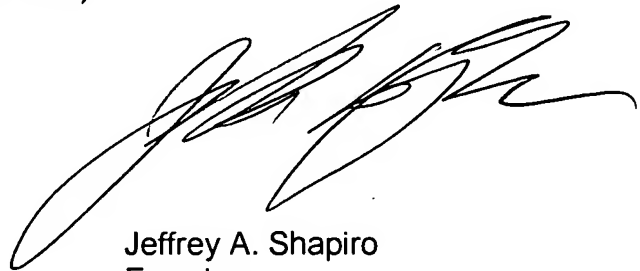
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

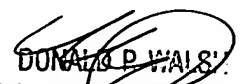
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro
Examiner
Art Unit 3653

9/4/04



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